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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR      | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|---------------------------|---------------------|------------------|
| 09/801,090  | 03/08/2001  | Antonio A. Avides Moreira | P 0278094 9780US    | 6854             |
| 909   | 7590        | 07/07/2004                | EXAMINER            |                  |
| PILLSBURY WINTHROP, LLP<br>P.O. BOX 10500<br>MCLEAN, VA 22102 |             |                           | PURVIS, SUE A       |                  |
|   |             |                           | ART UNIT            | PAPER NUMBER     |
|   |             |                           | 1734                |                  |
| DATE MAILED: 07/07/2004                                       |             |                           |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                       |  |
|------------------------------|------------------------|-----------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b>   |  |
|                              | 09/801,090             | AVIDES MOREIRA ET AL. |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>       |  |
|                              | Sue A. Purvis          | 1734                  |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 10-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 2 is/are allowed.
- 6) ☒ Claim(s) 3, 4, 6, 7 and 10-12 is/are rejected.
- 7) ☒ Claim(s) 5, 8, 13 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Kutsch (US Patent No. 4,342,806).

Applicant claims a thermoplastic component molded from a thermoplastic elastomer material which is stretched and then relaxed at ambient temperature. The preamble of the claim which discusses that the thermoplastic component is for sealing or connecting fails to add any patentable weight to the claims. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Kutsch discloses an elastomeric spring belt suitable for use as an energy absorber. The belt having preformed endless path and comprises a plurality of strands, tapes or films of a copolyetherester elastomer. The belt when stretched from about 5-30% of the length of its perimeter returns to substantially its original size when force is removed.

3. Claims 7, 10-12, and 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by the admitted prior art.

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Applicant admits on pages 1 and 2 of the specification that sealing components of thermoplastic elastomer materials are known and find wide application as a body plug, gasket rings, sealing rings, and shrink-on sleeving.

Absent a showing to the contrary, it is the examiner's position that the article disclosed by the applicant is identical or only slightly different that the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show obvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). The applied art either anticipates or strongly suggests the claim subject matter. It is noted that if the applicant intends to rely on Examples in the specification to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in the scope with the claims and how Comparative Examples are commensurate in scope with the prior art.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kidd et al. (US Patent No. 4,533,321) in view of JP 2000-154310 A (JP '310).

Applicant claims a thermoplastic component molded from a thermoplastic elastomer material which is stretched and then relaxed at ambient temperature. The preamble of the claim which discusses that the thermoplastic component is for sealing or connecting fails to add any patentable weight to the claims. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Kidd discloses a braided elastomer orthodontic tensioning device which are made from extruded thermoplastic polyurethane elastomer. (Col. 2, lines 16-20.)

An alternative to extruding the elastomer is to create it by a mold as discussed in JP '310.

It would have been obvious to one having ordinary skill in the art that the elastomer can be formed by either extruding the material or molding the material and is a matter of design choice, because both methods of creating an elastomeric material are well known in the art. (See also Kidd at col. 1, lines 37-42). Regarding the steps of stretching the component and then relaxing the material at ambient temperature, these steps are performed when a person uses the braided thermoplastic elastomer. The material is stretched and relaxed in preparation of being placed in the user's mouth or stretched prior to being placed in the user's mouth and relaxed once placed in position. (See Wallshein (US Patent No. 3,961,421); Col. 1, lines 23-46).

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***Allowable Subject Matter***

6. Claims 5, 8, 13, and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 1 and 2 are allowed.

8. The following is an examiner's statement of reasons for allowance: Prior art fails to teach the detailed steps of making a connection as set forth in these claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Response to Arguments***

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Sue R.', with a stylized flourish extending to the right.

Sue A. Purvis  
Primary Examiner  
Art Unit 1734

SP  
July 5, 2004